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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,144	09/08/2003	Jack Lee	13921 B	5414

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/658,144

Applicant(s)

LEE, JACK

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1. Claims 1-7 are pending in the application.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “generally comprising” in claim 1 is unclear and renders the claims vague and indefinite. It is unclear if Applicant is positively claiming all the limitations that follow this phrase or if Applicant is merely optionally claiming. The word “generally” implies that the cushion does not always have to comprise everything listed.

The term “foaming material EVA” in claims 6 and 7 is unclear and renders the claims vague and indefinite. It is unclear if Applicant is claiming a foam material such as EVA or if Applicant is claiming foamed EVA. Furthermore, it is unclear what “EVA” stands for, i.e. ethylene vinyl acetate, extra vehicular active, etc.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Oakley (U.S.

Patent No. 4,864,740).

Oakley discloses a hygienic shoe insole that includes an antimicrobial, fragrant and odor-absorbing agent (*col. 1, lines 7-10*).

Regarding Applicant's claim 1, Oakley discloses a cushion fabric (*shoe insole, col. 1, line 7*) generally comprising a first breathable layer (*top layer or bottom layer, col. 2, lines 9-12*), a filter layer (*composite layer, col. 2, line 11*) and a second breathable layer (*top layer or bottom layer, col. 2, lines 9-12*). The first and second breathable layers are non-woven fabrics (*col. 1, lines 39-47*) and the filter layer contains active carbon (*col. 3, lines 9-11*).

The limitation "the three layers being integrally combined together to form the cushion fabric by hot pressing approach ..." is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Oakley discloses a cushion fabric generally comprising a first breathable layer, a filter layer and a second breathable layer.

Regarding Applicant's claims 2 and 3, Oakley discloses that the cushion further comprises an adhesion layer (*adhesive, col. 4, lines 55-56*) attached to either the first or second breathable layer (*bottom layer, figure 2*).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McBarron (U.S. Patent No. 4,438,573) in view of Oakley.

Regarding Applicant's claim 1, McBarron discloses a ventilated athletic shoe (*title*) comprising an adhesion layer (*slip sole, col. 3, line 41*) and a cushion (*insole, col. 3, line 33*).

McBarron fails to disclose the cushion generally comprising a first breathable layer, a filter layer and a second breathable layer.

Oakley discloses a cushion fabric (*hygienic shoe insole*) that includes an antimicrobial, fragrant and odor-absorbing agent (*col. 1, lines 7-10*).

Oakley discloses that the cushion fabric (*shoe insole, col. 1, line 7*) generally comprising a first breathable layer (*top layer or bottom layer, col. 2, lines 9-12*), a filter layer (*composite layer, col. 2, line 11*) and a second breathable layer (*top layer or bottom layer, col. 2, lines 9-12*). The first and second breathable layers are non-woven fabrics (*col. 1, lines 39-47*) and the filter layer contains active carbon (*col. 3, lines 9-11*).

The limitation “the three layers being integrally combined together to form the cushion fabric by hot pressing approach ...” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Oakley discloses a cushion fabric generally comprising a first breathable layer, a filter layer and a second breathable layer.

McBarron and Oakley are analogous because disclose shoes.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Oakley’s insole as McBarron’s insole in order to make McBarron’s shoe more hygienic. One of ordinary skill in the art would have been motivated to Oakley’s insole because it includes an antimicrobial, fragrant and odor-absorbing agent (*Oakley col. 1, lines 7-10*). It is desirable to have an insole with an antimicrobial, fragrant and odor-absorbing agent because it will help the shoe not to smell bad for the consumer.

Regarding Applicant’s claims 2 and 3, the combination of McBarron and Oakley discloses that the cushion further comprises an adhesion layer (*McBarron, slip sole, col. 3, line 41*) attached to either the first or second breathable layer (*Oakley, top layer or bottom layer, col. 2, lines 9-12*).

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Regarding Applicant's claims 4 and 5, McBarron discloses wherein the adhesion layer is defined with plural gas holes, each paired neighboring gas holes are connected by a groove respectively (*col. 3, lines 41-60 and figure 5*).

Regarding Applicant's claims 6 and 7, McBarron discloses the adhesion layer is made of foaming material EVA, since reference discloses that all the pieces of the shoe are made of a resilient sponge material (*col. 4, lines 36-37*) such as ethylene vinyl acetate (EVA) sponge (*col. 2, lines 59-60*).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alicia Chevalier

2/5/05